

REMARKS

I. Introduction

Applicants respectfully request reconsideration of the present application in view of the accompanying Rule 132 declaration and these remarks.

II. Status of the Claims

No claims are amended currently. Claims 1-27 are pending. The PTO has withdrawn from consideration claims 4-7, 11-13, and 15-27 as directed to non-elected subject matter. Thus, claims 1-3, 8-10, and 14 are examined on the merits.

III. The Office Action

A. Provisional Non-Statutory Double Patenting

The PTO provisionally rejected claims 1-3, 8-10, and 14 over claim 24 of co-pending application No. 10/388,173 ("the '173 application"). Office Action at page 4 (point 5). In support of the rejection, the PTO acknowledged that the present claims specify the positions of radiolabels, while the '173 application claims encompass compounds containing radiolabels in unspecified positions. The PTO concluded that a double patenting issue exists because "both sets of claims are directed to compounds that have radiolabels." *Id.*

Applicants respectfully acknowledge PTO's rejection. They request, however, that the PTO to hold the rejection in abeyance until such time as the PTO indicates allowable subject matter. If, at that time, a double patenting issue still exists, then Applicants will address merits of the rejection.

B. Rejection of Claims Under 35 U.S.C. § 103(a)

The PTO rejected claims 1-3 and 14 over Mathis *et al.*, 46 *J. Med. Chem.* (2003) 2740-54 ("Mathis"). Office Action at page 4. The PTO drew particular attention to compound 19 of Mathis, which compound "encompasses Applicant's compound" *Id.* at 5. Applicants respectfully traverse the rejection.

To the extent that the PTO relies upon Mathis for its disclosure of compound 19, Mathis does not render obvious the claimed genus because claim 1, by virtue of its first proviso, expressly excludes compound 19. Accordingly, there is no structural nexus between compound 19 and the claims, and no sense in which Mathis “encompasses” Applicants’ claims.

Moreover, Mathis does not qualify as prior art to the present application. Specifically, Mathis would be prior art under only 35 U.S.C. § 102(a), but the accompanying Rule 132 declaration, by co-inventor Klunk, attests to the fact that the relevant aspects of Mathis are not work “by another,” contrary to the requirements of Section 102(a). Accordingly, Applicants urge the PTO to reconsider and withdraw the rejection.

C. Withdrawn Subject Matter

The PTO stated that it expanded its search of the claims relative to Applicants’ elected species before identifying art that could be used to reject the claims, and the PTO therefore withdrew non-elected subject matter. Office Action at page 2. The PTO additionally withdrew those claims that do not read on the searched subject matter. *Id.*

Now that Applicants have removed as incompetent the only publication cited for prior art purposes, Applicants kindly urge the PTO to broaden its search and examination as mandated under MPEP § 803.02. Additionally, Applicants respectfully request the PTO to rejoin withdrawn method claims 15-27 upon its finding that product claims are allowable.

D. Miscellaneous

Finally, the PTO requested that Applicants provide the year of three (3) publications cited on Applicants’ Information Disclosure Statement (“IDS”) that was filed on April 20, 2004. The publications are designated as Deardoff, Avis, and Balant.

Applicants regret their inadvertent omission of publication years on the IDS. Deardoff and Avis are chapters of the same treatise listed on the IDS (Remington’s Pharmaceutical Sciences, 15th Edition). It was published in 1975. The prefatory material included with Avis in the IDS clearly identifies the year of publication.

Balant is a chapter of another treatise that was published in 1995 (Burger's Medicinal Chemistry and Drug Discovery). This publication year is clearly marked on the chapter's table of contents page and in the prefatory material of the treatise itself.

CONCLUSION

Having addressed each of the examiner's stated concerns, Applicants believe that the present application in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. Examiner Jones is kindly urged to contact the undersigned by telephone if she feels that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date 18 May 2006

By S. A. Bent

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5404
Facsimile: (202) 672-5399

Stephen A. Bent
Attorney for Applicant
Registration No. 29,768

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.